

REMARKS

I. PRELIMINARY REMARKS

Claims 11, 14, 17, 19 and 20 have been amended. Claims 37-41 have been added. Non-elected claims 1-10 and 31-36 have been canceled. Claims 11-30 and 37-41 remain in the application. Reexamination and reconsideration of the application, as amended, are respectfully requested.

Applicant notes with appreciation that the Examiner has indicated that claims 21-30 have been allowed and that claims 14-17, 19 and 20 would be allowable if rewritten in independent form. As claims 14 (from which claim 15 and 16 depend), 17, 19 and 20 have been rewritten in independent form, applicant respectfully submits that claims 14-17, 19 and 20 are in condition for allowance.

II. CONSIDERATION OF INFORMATION DISCLOSURE STATEMENTS

The outstanding Office Action includes Examiner-initialed versions of the PTO form 1449s from the Information Disclosure Statements ("IDSs") that were filed on June 12, 2001, October 8, 2001 and February 16, 2002. The past and outstanding Office Actions have not, however, included any indication that the IDSs filed on the following dates have been considered:

1. June 29, 2001
2. August 26, 2001
3. September 22, 2001
4. January 3, 2002
5. July 24, 2002
6. September 27, 2002
7. November 15, 2002

An additional IDS was also filed on April 12, 2003, i.e. after the mailing of the outstanding Office Action. Applicant hereby requests that the Examiner consider all eight (8) of the IDSs that have yet to be considered, initial the PTO form 1449s and return them to applicant with the next Office Action. Should any of these IDSs be

missing from the USPTO file, applicant respectfully requests that the Examiner call the undersigned representative so that copies can be provided.¹

III. PRIOR ART REJECTIONS

A. The Rejections

Claims 11-13 and 18 have been rejected under 35 U.S.C. § 102 as being anticipated by U.S. Patent No. 6,454,758 to Thompson ("the Thompson '758 patent"). The rejection under 35 U.S.C. § 102 is respectfully traversed with respect to the claims as amended above. Reconsideration thereof is respectfully requested.

B. Discussion

Independent claim 11 calls for a combination of elements comprising "an outer member," "an elongate body carried within the outer member interior bore and defining a distal region and a distal end operably connected to the distal end of the outer member," "an inflatable tissue coagulation body supported on the elongate body distal region" and "at least one sensing element supported on the tissue coagulation body proximal to the inflatable tissue coagulation body." The cited reference fails to teach or suggest such a combination.

The Thompson '758 patent discloses a variety of electrode supporting structures. Referring first to Figures 82-84, some of the electrode supporting structures include a body 428 that supports electrodes 429. Porous material 430 covers the electrodes 429 and the space between the porous material and the electrodes may be filled with conductive fluid. In contrast to the invention defined by independent claim 11, however, there are no sensing elements carried by the body 428 proximal to the porous material 430.

¹ Applicant notes that copies of the IDSs filed June 29, 2001, August 26, 2001, September 22, 2001 and January 3, 2002 were already provided with the

The Office Action also made reference to Figure 55 of the Thompson '758 patent. The device illustrated in Figure 55 includes an anchoring branch 276 with an anchoring balloon 346. In contrast to the invention defined by independent claim 11, however, the anchoring balloon 346 simply is not "an inflatable tissue coagulation body," as this term is used in the present application.²

As the Thompson '758 patent fails to teach or suggest each and every element of the combination recited in independent claim 11, applicant respectfully submits that claims 11-13 and 18 are patentable thereover and that the rejection under 35 U.S.C. § 102 should be withdrawn.

IV. NEWLY PRESENTED CLAIMS 37-41

Newly presented claim 37 depends from independent claim 11 and, accordingly, is patentable for at least the same reasons as claim 11.

Newly presented claims 38-41 respectively depend from independent claims 14, 17, 19 and 20 and, accordingly, are patentable for at least the same reasons as claims 14, 17, 19 and 20.

V. CLOSING REMARKS

In view of the foregoing, it is respectfully submitted that the claims in the application are in condition for allowance. Reexamination and reconsideration of the application, as amended, are respectfully requested. Allowance of the claims at an early date is courteously solicited.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is respectfully requested to call applicant's undersigned

amendment filed on November 18, 2002.

² As discussed in *In re Cortright*, 49 USPQ2d 1464, 1467 (Fed. Cir. 1999), claims in an application are to be given their broadest reasonable interpretation. This interpretation must be "consistent with the specification" and "consistent with the one that those skilled in the art would reach." *Id.*

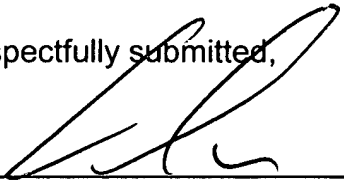
representative at (310) 563-1458 to discuss the steps necessary for placing the application in condition for allowance.

The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 50-0638. Should such fees be associated with an extension of time, applicant respectfully requests that this paper be considered a petition therefor.

9/7/03
Date

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Respectfully submitted,



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